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In re Application of JOHNSON et al :
U.S. Application No.: 10/521,138 :
PCT Application No.: PCT/US03/23155 :
Int. Filing Date: 23 July 2003 : COMMUNICATION
Priority Date Claimed: 23 July 2002 :
Attorney Docket No.: 019957-015920US :
For: SYNTHESIS OF GLYCOPROTEINS USING :
BACTERIAL GLYCOSYLTRANSFERASES :

This application is before the Office of PCT Legal Administration for consideration of issues arising under the Patent Cooperation Treaty.

BACKGROUND

On 23 July 2003, applicant filed international application PCT/US03/23155, which claimed priority of an earlier United States application filed 23 July 2002. The thirty-month period for paying the basic national fee in the United States expired on 23 January 2005.

On 12 January 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1), a Transmittal Letter to the DO/EO/US Concerning a Submission Under 35 U.S.C. 371 (Form PTO-1390), an Application Data Sheet (ADS), and a preliminary amendment.

On 06 October 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 and a sequence listing in compliance with 37 CFR 1.821 *et seq.* must be filed.

On 06 December 2005, applicant filed, *inter alia*, a new Transmittal Letter (Form PTO-1390), a new ADS, an executed declaration, and a sequence listing.

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DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official USPTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states in relevant part:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111....


If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111. (Emphasis added.)

Although the Transmittal Letter and ADS filed 12 January 2005 identified the application as a national stage application being filed under 35 U.S.C. 371, the concurrent submission of the preliminary amendment which indicated that the application "is a continuation of International Application No. PCT/US/2003/023155, filed July 23, 2003 and a continuation of International Application No. PCT/US/2003/023057, filed July 23, 2003" is inconsistent with and would have contradicted any desire expressed in any papers that might have been filed to enter the national stage of the PCT under 35 U.S.C. 371. See MPEP 1893.03(a), which states, "A conflicting instruction will be present, for example, where applicant includes in the initial submission under 35 U.S.C. 371, ... a benefit claim under 35 U.S.C. 120 to the international application." Moreover, it is not possible under 35 U.S.C. 371 to file a national stage entry of an international application which is a continuation of the same international application. However, it is permissible to file a continuation of one or more international applications under 35 U.S.C. 111(a). Because the 12 January 2005 submission was not clearly and unambiguously identified as a filing under 35 U.S.C. 371, the submission should have been treated as a submission under 35 U.S.C. 111(a).

CONCLUSION

The Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 06 October 2005 is hereby VACATED.

This application is being forwarded to the Office of Initial Patent Examination for further processing in accordance with this decision, including treatment of the application as a continuation application filed under 35 U.S.C. 111(a).


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